



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/716,397

11/20/2003

Katsuaki Akama

1086.1187

5532

21171 7590 06/09/2009
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

GYORFI, THOMAS A

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/716,397	Applicant(s) AKAMA, KATSUAKI	
	Examiner Thomas Gyorfi	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 remain for examination. The correspondence filed 3/25/09 amended claims 1, 7, 11, and 12.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/25/09 has been entered.

Response to Arguments

3. Applicant's arguments filed 3/25/09 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4. Specifically regarding to the Sanchez-Herrero reference, Applicant argues:

More specifically, the present invention provides a benefit of the server holding the telephone number and the terminal has no relationship with the telephone number for purpose of positional registration permitting use of a plurality of cell phones with a single telephone number, namely the language of claim 1 provides "*receiving from thea_.second wireless terminal equipment an authentication request containing the user-*

Art Unit: 2435

biological information of said user and a-second terminal subscriber identification information el-a-for the second wireless terminal equipment." In contrast, in Sanchez Herrero, each terminal transmits the same telephone number along with IP address of each respective terminal to a server. Thus, Sanchez Herrero does not disclose expressly or implicitly the language of claim 1 providing a benefit of positional registration permitting use of a plurality of cell phones by the user with a single telephone number.

Examiner disagrees with this argument, particularly as the term "terminal subscriber identification information" is not limited to a "telephone number" as argued above. Sanchez-Herrero discusses at great length that both the general body of prior art and his invention in particular entail the use of both private and public IDs representative of an individual user. The private-ID is the single identifier used by the phone network to consistently identify the same user across all terminal equipment used, while the public-IDs identify each individual handset that the user may register to his account (e.g. col. 4, lines 1-15). When a user in the Sanchez-Herrero invention wishes to register a second device to his account, he uses the second device to send a registration message including the public-ID indicative of the user, which compels the registration server to update its records such that the newly received public-ID represents the new phone to which calls should be directed, overwriting whichever public-ID had previously been recorded as the active phone (col. 11, lines 50-65).¹ It should also be noted that even if the claims were amended to specifically recite the use of telephone numbers in a registration message, Sanchez-Herrero discloses wherein telephone numbers were typically known to be included in registration messages anyway (col. 4, line 50 – col. 5, line 2), thus further rendering the claim obvious.

¹ It is observed that Sanchez-Herrero is not limited to permitting only one active phone per user, but in fact one of the disclosed advantages over the prior art is the ability to configure the system to allow multiple active lines if so desired (col. 6, lines 40-67).

Art Unit: 2435

5. Specifically regarding to the Teitelbaum reference, Applicant argues:

The Examiner also relies upon Teitelbaum col. 8, lines 50-57, however, this only discusses when there is a message in the voice mailbox of the user, there occurs a change in the telephone tone to urge the user to access the voice mail. Teitelbaum discusses that to listen to a received voice message, the user must transmit a call from a telephone having a biological sensor.

Examiner observes that the Office Action did not limit itself to that citation but also referenced all previously cited passages; in particular, col. 7, lines 30-50 which discloses that when a user desires to use any phone belonging to that invention for any reason – making an outbound call, voice mail, long distance calls, etc. - they must first authenticate themselves in a process that includes the use of biometric information. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing a response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage(s) as taught by the prior art or disclosed by the Examiner.

6. Additionally, with regards to Applicant's argument that "*...the language of claim 1 require[s] limitations for a positional registration permitting use of a plurality of cell phones with a single telephone number*" (amendment of 3/25/09, e.g. page 8, lines 21-24), Examiner observes that this is an overly strict interpretation of the claim language. The independent claims provide to the user the ability to register a first wireless terminal equipment [e.g. a cell phone] - said registration necessarily involving biometric information – then said user subsequently registering oneself with a second wireless terminal equipment, wherein said second wireless equipment is provided with updated personal information to allow the user to use the second device as their new phone. Not only do the claims not

Art Unit: 2435

provide any limitation that the first phone may still be used by the user after the second device is registered, but the claims as currently written appear to suggest that it would **not** be possible to continue to use the first phone afterwards. Observe that the claims recite wherein the database updates its records by changing the first terminal subscriber information into the second terminal subscriber information. The claims provide no further guidance as to how this change is implemented, so if the change is implemented in the database's permanent memory, then by definition it will have erased its memory of the first cell phone and as a consequence, if a user tries to use the first phone one of ordinary skill in the art would surmise that it would be rejected as no longer being registered in the system of the instant invention. In any case, as discussed above the Sanchez-Herrero reference anticipates all possible interpretations of the disputed claim language (see. col. 6, lines 40-67).

7. In order to better address Applicant's concerns, the rejections of the claims have been rewritten and are presented below.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez Herrero et al. (U.S. Patent 7,177,642) in view of Teitelbaum (U.S. Patent 5,872,834).

Art Unit: 2435

Regarding claims 1, 7, and 11:

Sanchez Herrero discloses a method, program, and apparatus for registering the position of wireless terminal equipment (wireless disclosed at col. 5, lines 20-50 and col. 7, lines 60-67), comprising: registering in a database personal information, the personal information linking a subscribed terminal number, a terminal subscriber identification number and user charging information to biological information of a user possessing the wireless terminal equipment (the HSS: col. 8, lines 45-50); transferring subscribed terminal number and said first terminal subscriber identification information from among the personal information to an exchange to request registration of position information permitting call in and call out of said first wireless terminal equipment by said subscribed terminal number (all of columns 10 and 11, but particularly col. 10, lines 10-30); receiving from a second wireless terminal equipment an authentication request containing second terminal subscriber identification information for the second wireless terminal equipment (Ibid, but particularly col. 11, lines 15-40); retrieving personal information of the first wireless terminal equipment and updating the retrieved personal information by changing terminal subscriber information in the retrieved personal identification into the received terminal subscriber identification information (changing the active public-ID from the first to the second device: col. 11, lines 50-65); transferring the subscribed terminal number in the retrieved personal information and the changed terminal subscriber identification information in the updated personal information to the exchange and requesting position information registration which enables call in and call

Art Unit: 2435

out as a terminal equipment having the subscribed terminal number (col. 11, line 65 – col. 12, line 5).

Sanchez-Herrero does not disclose the use of biometric [“biological”] information as part of the process to register terminal equipment. However, Teitelbaum discloses an analogous method to register a phone to a user that incorporates the use of biometric information such as a fingerprint (col. 8, line 64 – col. 9, line 10). It would have been obvious to incorporate biometric information as part of the cellphone registration process disclosed by Sanchez-Herrero. The motivation for doing so would be to allow a user to access features specific to his phone subscription from any phone, not just those with a specific phone number (Ibid, and also col. 3, lines 45-50).

Regarding claims 2, 8, and 12:

Sanchez-Herrero and Teitelbaum further disclose notifying a terminal equipment which has been used so far of renouncement of its use when the position information is requested of the exchange which enables call in and call out as a terminal equipment having the subscribed terminal number based on the authentication of biological information from a new terminal equipment by the received authentication request, retrieved personal information, and the transferred subscribed terminal number (Sanchez-Herrero: col. 13, lines 5-35; Teitelbaum: col. 8, lines 5-11 and lines 20-35).

Art Unit: 2435

Regarding claims 3, 9, and 13:

Teitelbaum further discloses wherein the biological information received by the received authentication request is biological information read in real time into the terminal equipment (e.g. col. 8, lines 40-50).

Regarding claims 4, 10, and 14:

Sanchez-Herrero and Teitelbaum further disclose wherein the personal identification management step includes registering charged user identification information of a specific person among group members as common charged user identification of a plurality of terminal equipments owned by group members such that the specific person is charged (Sanchez-Herrero: col. 5, lines 20-35; Teitelbaum: col. 8, lines 10-35).

Regarding claim 5:

Sanchez-Herrero and Teitelbaum further discloses wherein the terminal equipment is a cellular phone (Sanchez-Herrero: Examiner takes Official Notice that terminal equipment adhering to the 3G mobile network standard would reasonably be a cellular phone; Teitelbaum: Figure 12, and col. 8, line 64 – col. 9, line 10).

Regarding claim 6:

Teitelbaum further discloses wherein the biological information is a fingerprint, venous vascular network, palm print, palm shape, facial image, ear shape, or iris (e.g. col. 4, lines 20-30).

Art Unit: 2435

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: the various 3GPP specifications incorporated by reference by Sanchez Herrero (col. 4, lines 25-35; col. 8, line 60 – col. 9, line 10), as well as RFC2534 (col. 4, lines 35-45) have been included herein.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Gyorfi whose telephone number is (571)272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG

6/4/09

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435